

## REMARKS

Claims 1-53 are pending in this application. The Office Action dated April 5, 2002, rejected Claims 1-53. Applicants have amended Claims 1, 5, 48, and 50 to further clarify the subject matter of the claimed invention.

### **Claims rejected under 35 U.S.C. § 102(e).**

The Office Action has rejected independent Claims 1, 5, 48 and 50 and dependent Claims 2-3, 6-16, 19-30, 37 and 39 under 35 U.S.C. § 102(e) as being anticipated by Ho et al. U.S. Patent 6,021,412, hereinafter referred to as "Ho". Applicants respectfully request reconsideration in view of the amendments to the claims and the following discussion.

Claim 1, subparagraph (a), teaches automatically creating a query directly from the indicated object, the query having a data structure that is recognizable by a search engine for the database. As is clear by the amended claim, the query is created directly from the indicated object.

In contrast, Ho discloses a method for creating a query by "identifying a concept expressed by the ... text" (see column 9, lines 39-40). The concepts are identified by "parsing the portion of the text to identify words that correspond to words in a list of concept words" (see column 9 lines 61-63). Figure 4 shows employing an "AutoClipArt" facility in a presentation application to activate the method disclosed by Ho. After the method is invoked, the steps for creating a query, as shown in Figure 5, include identifying each occurrence of a concept-matching word in a document (501), generating a list of the concept lemmas (502), prompting the user to select a concept lemma (503), identifying representative synonym (505), querying graphics library (506), and displaying the graphics (507).

As indicated by steps 502 and 503 in Figure 5, Ho creates a query for images based on a concept lemma that is indirectly selected. Ho's concept lemma is not a portion of the text in the document that is selected by a user. Instead, a list of concept lemmas is generated by analyzing the entire document; and these generated concept lemmas are provided to the user for selection. A query for images is generated based on the selected concept lemma. Clearly, since Ho's process for creating the query employs an indirectly generated concept lemma and not creating the query directly from the indicated object as taught by Claim 1, subparagraph (a), the claimed invention is neither anticipated nor made obvious in view of the cited reference.

Additionally, independent Claims 5, 48 and 50 have been amended to further clarify the subject matter of the claimed invention. Claim 5 is directed toward a method for searching, obtaining and displaying images that are related to indicated text in a document. Also, Claim 48 relates to a system with a client-server architecture that implements actions substantially similar to the method taught in Claim 1. Additionally, Claim 50 involves a computer readable medium having computer-executable components that implement actions substantially similar to those in Claim 1. Since independent Claims 5, 48 and 50 have been amended and are substantially similar to Claim 1, these claims are not anticipated or made obvious for at least the same reasons in regard to Claim 1.

Additionally, the Ho reference does not anticipate or make obvious dependent Claims 2-4, 6-47, and 49, for at least the same reasons as the independent claims, upon which they depend.

**Claims rejected under 35 U.S.C. § 103.**

The Examiner rejected Claims, 4, 18, 31-36, 38, 40-47, 49, and 51-53 under 35 U.S.C. § 103(a) as being unpatentable over Ho et al. (U.S. Patent 6,021,412) and in view of Balogh et al, U.S. Patent No. 5,493,677. Hereinafter referred to as "Balogh". The Office Action also rejected

dependent Claim 17 as being unpatentable over Ho in view of Baru et al, U.S. Patent No.

6,021,412. Hereinafter referred to as "Baru". Applicants respectfully disagree with the basis of this rejection and request reconsideration of these claims in view of the following discussion.

Applicants challenge the assertions in the Office Action that it would have been obvious at the time of the invention to combine the Ho and Balogh references and the Ho and Baru references.

Specifically, Applicants seasonably challenge the assertion in the Office Action that "it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine Ho's database searching method with Balogh's purchasing step." (April 5, 2002 Office Action, Page 9, lines 20-22). There is no motivation to combine the Balogh reference with the Ho reference. Additionally, there is not a reasonable expectation of success to combine the Ho and Balogh references.

Additionally, Applicants also seasonably challenge the assertion in the Office Action that "it would have been obvious to one ordinarily skilled in the art at the time of the invention to implement Ho's invention using XML in order to provide a user-friendly query formulation and optimization." (April 5, 2002 Office Action, Page 14, line 21, Page 15, lines 1-2). There is no motivation to combine the Baru reference with the Ho reference. Additionally, there is not a reasonable expectation of success to combine the Ho and Baru references.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine. The suggestion or motivation must be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Third, the references must teach or suggest all the claim limitations.

MPEP 2143. Applicants respectfully disagree with the Office Actions combination of the references.

The proposed combinations cited in the Office Action change the principle of operation of the references. When the "proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01, *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). With regard to the combination proposed by the Office Action, substantial modifications would have to be made in order to make the combination operable.

The combination of Ho with Balogh is not obvious because there is no motivation or suggestion to combine these references. Additionally, the combination of Ho with Balogh is not obvious because the references have different methods that solve different problems. For example, Ho discloses searching a graphics library where concept-matching words are identified (figure 5, step 501), mapped to concept lemmas (step 502), and lemmas are mapped to concept representative synonyms (step 505) before querying the database (step 506). Ultimately, graphics may be added to a document for illustrating concepts referred to therein (see column 1, line 38-40).

In comparison, images in Balogh are archived and retrieved by associating metadata with an image, the metadata including bibliographic data, a caption, and a set of suggestions evoked by the image, removing ambiguities from the metadata, storing the image and metadata in a database with other images and metadata, and selecting certain images from the database that have metadata corresponding to a user's search request. (See column 1, lines 56-64). Images and their associated metadata are analyzed and cataloged using natural language processing.

Balogh's image retrieval is also accomplished by using the natural language processing to analyze user requests.

Also, there is no teaching in the Ho and Balogh references that would suggest combining the functionality of these references would be successful. Ho clearly teaches away from the precision necessary to effectively practice Balogh's natural language processing method. For example, Ho's use of a fixed set of synonyms relies upon a certain level of ambiguity in order to find a range of images in a graphics library. Further, one given example in Ho discloses searching for images to match the concept of 'Leadership' and returning several different images that cover the broadest definition of leadership. (See column 6, lines 27-32). On the other hand, Balogh expends considerable effort to avoid ambiguity. In particular, the Balogh specification discloses a detailed method for resolving precise meanings. (See Figure 4; Figure 10, steps 1003-1011; column 6, line 28 to column 7, line 25; and column 12, line 57 to column 13, line 57). Also, the purchase step disclosed in Balogh discloses delivery of images in physical media (slides or prints) or electronic media using conventional bulletin boards. (See column 18, lines 2-4).

For the above reasons, independent Claim 51 and dependent Claims 4, 18, 31-36, 38, 40-47, 49, and 52-53 are not obvious for at least the same reasons as discussed above.


### **Conclusion**

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Attached to this response are pages entitled "MARKED VERSION OF AMENDED CLAIMS SHOWING CHANGES" that illustrate the changes made to the paragraphs and claims amended above.

Respectfully Submitted,

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MARKED VERSION OF AMENDED CLAIMS SHOWING CHANGES

1. (Twice Amended) Method for searching a database to obtain an object that is related to an indicated object in a document, comprising:

- (a) automatically creating a query [related to] directly from the indicated object, the query having a data structure that is recognizable by a search engine for the database;
- (b) providing the query to the search engine, the search engine searching the database for at least one object that is related to the indicated object;
- (c) returning the result from the query of the database, the result indicating when at least one object is related to the indicated object; and
- (d) producing a display of a related object, so that the related object may be associated with the indicated object.

5. (Amended) Method for obtaining an image from a database for insertion into a document, the image being related to indicated text, comprising:

- (a) enabling an automatic creation of a query [related to] directly from the indicated text, the query having a data structure that is recognizable by a search engine for the database;
- (b) providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text;
- (c) returning the result from the query of the database, the result indicating when at least one image is related to the indicated text;
- (d) enabling the display of at least one image indicated by the result from the query, a displayed image being selectable for insertion into the document; and
- (d) displaying a related image that is inserted into the document, so that the related image is associated with the indicated text in the document.

48. (Amended) A system for obtaining an image from a database for pasting into a document, the image being related to indicated text, comprising:

(a) a client process for causing functions to be performed, including:

(i) enabling an automatic creation of a query [based on] directly from the indicated text, the query having a data structure that is recognizable by a search engine for the database;

(ii) providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text;

(iii) enabling a display of at least one related image indicated by the result from the query, the display of a related image being selectable for insertion into the document; and

(iv) displaying the related image that is inserted into the document, the related image being associated with the indicated text in the document; and.

(b) a server process for causing functions to be performed, including:

(i) returning the result from the query of the database, the result indicating when at least one image is related to the indicated text; and

(ii) enabling the search engine to locate at least one image in the database that is related to the indicated text.

50. (Amended) A computer readable medium having computer-executable components, comprising:

(a) a component for automatically creating a query [related to] directly from indicated text, the query having a data structure that is recognizable by a search engine for a database;

(b) a component for providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text;

(c) a component for returning the result from the query of the database, the result indicating when at least one image is related to the indicated text;



(d) a component for enabling the display of at least one related image indicated by the result from the query, the display of the related image being selectable for insertion into the document; and

(e) a component for displaying the related image that is inserted into the document, so that the related image is associated with the indicated text in the document.